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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,089	12/16/2004	Hidekazu Tanigawa	IRD-0002	3748
23353 7590 03/04/2009 RADER FISHMAN & GRAUER PLLC LION BUILDING 1233 20TH STREET N.W., SUITE 501 WASHINGTON, DC 20036				
EXAMINER ANTONIENKO, DEBRA L				
ART UNIT 3689		PAPER NUMBER		
MAIL DATE 03/04/2009		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/518,089

Applicant(s)

TANIGAWA, HIDEKAZU

Examiner

DEBRA ANTONIENKO

Art Unit

3689

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-5 and 8-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-5 and 8-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This is a Final Office Action in response to communications received December 9, 2008, wherein:

Claims 1, 2, 6, and 7 have been cancelled;

Claims 3-5 and 8-10 have been amended;

Claims 11-13 have been newly added; and

Claims 3-5 and 8-13 are pending.

Response to Amendment

2. Regarding the terms "read-in" and/or "reading-in," Applicant's cancellation of independent Claims 1 and 6, cancellation of Claims 2 and 7, and the removal of dependency of Claims 3-5 and 8-10 render the 112, second paragraph, rejection moot. However, such amendments do **not** obviate the vagueness and indefiniteness of the terms "reader" or "reading in" now limiting all amended and newly added claims.

Although claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Geuns*, 26 USPQ2d 1057 (CA FC 1993). Moreover, an essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed. *In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989).

3. Regarding the phrase "characteristic intrinsic to said specification," Applicant's cancellation of Claims 2 and 7, render the 112, second paragraph, rejection moot.

4. Regarding the 35 USC §101 rejection of Claims 1-10: Applicant's cancellation of Claims 1, 2, 6, and 7 render the rejection moot; Applicant's amendments to Claims 3-5 are sufficient to overcome the rejection; Applicant's amendments to Claims 8-10 are **not** sufficient to overcome the rejection.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 3-5 and 8-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In all claims, the terms "reader" or "reading in" are vague and indefinite. For example, does the invention read in from a scanner?

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 8-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As to Claims 8-10: Claims 8-10 recite a device, however, the "reader,"

"analyzer," and "calculator," as written, are considered to be software per se and not parts of a device or machine.

As to Claims 11 and 12: In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class such as a particular machine that imposes meaningful limits on the method claim's scope or (2) transform underlying subject matter (such as an article or materials). See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. With respect to independent Claims 11 and 12, the computer is merely mentioned in the preamble. It must be positively recited in the body of the claim showing its significant function in the invention. Therefore, the claim language does not include the required tie or transformation and thus is directed to nonstatutory subject matter.

As to Claim 13: Independent Claim 13 recites a program. It is unclear what Applicant means by "program." If Applicant means program to be a method or process, then Claim 13 is directed to nonstatutory subject matter for the same reasons set forth above for Claims 11 and 12. If Applicant means program to be a software program, then the claim as written is considered to be software per se unless there is an apparatus as well that is capable of executing the software appropriately in order to provide functionality. In other words, for applicant to claim the steps performed by the program, the applicant must recite the claims such that when the program is executed,

the program causes a computer/processor to perform the steps.

Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3-5 and 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barney et al., U.S. Patent Number 6,556,992 B1 (hereinafter Barney).

Regarding Claims 11, 8, and 3, Barney teaches, respectively, a method, a data processing device, and a program product stored in a computer readable medium that permits a computer to implement the following steps of: a specification analysis step of reading in a specification and analyzing said specification so as to obtain a number of words for preferred embodiment and a number of words of claims (column 11, lines 38-59; column 12, lines 7-23; *length of patent specification*); and a patent value output step of outputting said patent value (Figure 11).

Barney does not disclose a patent value calculation step of calculating a patent value using the following formula: {the number of words for preferred embodiment/the number of words for claims}. However, Barney suggests a *word density ratio* (e.g., *different-words/total-words*). It would have been obvious to one of ordinary skill in the art at the time of the invention to use different ratios in order to be able to provide a comprehensive quantifiable analysis.

Regarding Claims 12, 9, and 4, Barney teaches, respectively, a method, a data processing device, and a program product stored in a computer readable medium that permits a computer to implement the following steps of: a specification analysis step of reading in a specification and analyzing said specification so as to obtain the smallest number of elements composing one claim; a patent value calculation step of calculating a patent value using the smallest number of elements composing one claim obtained by the specification analysis step, as a parameter; and a patent value output step of outputting said patent value.

Barney discloses counting the number of elements in claims such that elements are words. Barney discloses generally using the "word count" of claims, smallest to largest, to illustrate statistical relationships (column 20, lines 18-28; Figure 4). Barney also discloses specific element counts used as quantifiable parameters such as the *frequency or infrequency of certain word usage relative to the general patent population*

or relative to a defined sub-population of patents in the same general field (column 11, line 38 – column 12, line 6).

Regarding Claims 13, 10, and 5, Barney teaches, respectively, a program, a data processing device, and a program product stored in a computer readable medium that permits a computer to implement the following steps of: a specification analysis step of reading in a specification and analyzing said specification so as to obtain a depth of claim nesting level or a number of claim categories; a patent value calculation step of calculating a patent value using the depth of claim nesting level, or the number of claim categories obtained in said specification analysis step, as a parameter; and a patent value output step of outputting said patent value (column 11, lines 38-59; *claim type*).

Response to Arguments

11. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEBRA ANTONIENKO whose telephone number is (571)270-3601. The examiner can normally be reached on Monday through Thursday, 7:30 AM to 4:00 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DA

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689
3/1/09